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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/728,783	11/30/2000	Jurgen Pingel	P-4582	2695

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Forrest Gunnison
Gunnison, McKay & Hodgson, L.L.P.
1900 Garden Road, Suite 220
Monterey, CA 93940

EXAMINER	
WONG, LESLIE	

ART UNIT	PAPER NUMBER
2177	8

DATE MAILED: 12/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/728,783	PINGEL ET AL.	
	Examiner	Art Unit	
	Leslie Wong	2177	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 September 2003*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Response to Amendment

1. Receipt of Applicant's Amendment, filed 30 September 2003, is acknowledged.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 1-5, 8-19, and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lawrence et al.** (U.S. Patent 6,289,342 B1) in view of **Amro et al.** (U.S. Patent 5,867,678).

Regarding claims 1, 12, 15, and 22, **Lawrence et al.** teaches a method, computer program, and storage medium for creating a reference database for a computer-readable document comprising:

a). entering user inputted reference data into the reference database (col. 6, lines 42-52); and,

b). storing the reference database and other data of the computer-readable document wherein said other data includes at least one citation to said user inputted reference data (col. 8, lines 12-17).

Lawrence et al. does not explicitly teach a step of storing the **reference database and other data** of the computer-readable document in a **single data file**.

Amro et al., however, teaches a compound document contains multiple objects capable of running within the document, such as a spreadsheet (i.e., database), text, and hotlinks etc... (col. 4, lines 4-7).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to store document related data in the same file because doing so would ensure that reference data is always available for access.

Regarding claims 2, 16, and 23, **Lawrence et al.** further teaches wherein the computer readable document further comprises a reference field for retrieving a record stored in the reference database (col. 6, lines 45-52).

Regarding claims 3 and 17, **Lawrence et al.** further teaches wherein the reference database further comprises:

a). fields for different types of reference data sources (col. 8, lines 11-17); and

b). fields containing specific information associated with these different types of reference data sources (col. 8, lines 11-17).

Regarding claims 4 and 18, **Lawrence et al.** further teaches wherein the reference database comprises a bibliographic database, and the reference data sources comprise books, journals, conference presentations, web-pages and e-mails (col. 5, line 65 – col. 6, line 40).

Regarding claims 5 and 19, **Lawrence et al.** further teaches wherein the reference database further comprises one field containing information about a number of citations of a reference in the document (col. 15, tables 2-4).

Regarding claim 8, **Lawrence et al.** further teaches wherein said method is stored as computer code in a storage medium (col. 8, lines 49-50).

Regarding claim 9, **Lawrence et al.** further teaches wherein said computer code is downloaded into said storage medium (col. 4, lines 8-11 and col. 8, lines 49-50).

Regarding claim 10, **Lawrence et al.** further teaches an apparatus for creating a reference database for a computer-readable document comprising:

a). a processor (Fig. 1); and

b). a storage medium coupled to said processor (elements 16 and 24 in Fig. 1).

c). a reference database, storing user inputted reference data together with a document in a single data file wherein said document includes at least one citation to information in said reference database.

The above limitation c corresponds with limitation b in claim 1 which have been analyzed as discussed in claim 1.

Regarding claim 11, **Lawrence et al.** further teaches wherein said processor is in a first device, and said storage medium is in a second device (col. 8, lines 21-28).

Regarding claim 13, **Lawrence et al.** further teaches wherein the computer-readable document further comprises reference fields (col. 8, lines 11-17).

Regarding claim 14, **Lawrence et al.** further teaches wherein the reference database contains fields for different types of reference data sources and fields containing specific information associated with these data sources (col. 8, lines 11-17).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 6 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lawrence et al.** (U.S. Patent 6,289,342 B1) in view of **Amro et al.** (U.S. Patent 5,867,678) as applied to claims 1-5, 8-19, and 22-23 above and further in view of **Nurse et al.** (U.S. Patent 5,097,418).

Regarding claims 6 and 20, **Lawrence et al.** and **Amro et al.**, do not clearly teach a step of displaying a user interactive dialogue window for inputting reference data.

Nurse et al., however, teaches a step of displaying a user interactive dialogue window for inputting reference data (col. 3, line 50 – col. 4, line 7).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to allow users to input reference data into the database in order to accumulate information from several sources (col. 3, lines 45-46).

6. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Lawrence et al.** (U.S. Patent 6,289,342 B1) in view of **Amro et al.** (U.S. Patent

5,867,678), and **Nurse et al.** (U.S. Patent 5,097,418), as applied to claims 6 and 20 above, and further in view of **Kanerva et al**. (U.S. Patent 6,507,858 B1).

Regarding claim 21, **Lawrence et al., Amro et al., and Nurse**, do not clearly teach a step of synchronizing the reference database with other data sources.

Kanerva et al., however, teaches a step of synchronizing the reference database with other data sources (col. 22, lines 20-49 and Fig. 6A).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to allow synchronizing the reference data with other data sources in order to reconcile the differences between sources and to assure that the stored information is up-to-date.

7. Claims 7 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lawrence et al.** (U.S. Patent 6,289,342 B1) in view of **Amro et al.** (U.S. Patent 5,867,678) as applied to claims 1-5, 8-19, and 22-23 above and further in view of **Kanerva et al**. (U.S. Patent 6,507,858 B1).

Regarding claims 7 and 24, **Lawrence et al.** and **Amro et al.** do not explicitly teach a step of synchronizing the reference database with other data sources.

Kanerva et al., however, teaches a step of synchronizing the reference database with other data sources (col. 22, lines 20-49 and Fig. 6A).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to allow synchronizing the reference data with other data sources in

order to reconcile the differences between sources and to assure that the stored information is up-to-date.

Response to Argument

8. Applicant's arguments filed 30 September 2003 have been fully considered but they are not persuasive.

Applicants argue that Lawrence teaches an autonomous citation indexing system. The system automatically searches for documents containing user specified keywords. The database that is created is based upon processing of these documents. Accordingly, Lawrence teaches away from "*entering user inputted reference data into the reference database.*" In response to the preceding arguments, Examiner respectfully submits that Lawrence utilizes the help of an assistant agent to perform tasks **on behalf of the user**, making interaction with the software system easier and/or more efficient (col. 5, lines 20-25). Since the user instructs the assistant agent to find, extract, and store the citation information, it is equivalent to that of the user performing the tasks on his/her own. Therefore, it is submitted that Lawrence does not teach away from the claimed limitation. Furthermore, Lawrence discloses that in an article entitled "A universal citation database as a catalyst for reform in scholarly communication" by R.D. Cameron, the prior art proposed a system whereby **authors or institutions must provide citation information** (i.e., user enter the citation information) in a specific format (col. 3, line 57 – col. 4, line 12). Hence, prior art teaches the limitation as claimed.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tabuchi (U.S. Patent 6,606,633 B1)

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leslie Wong whose telephone number is (703) 305-3018. The examiner can normally be reached on Monday to Friday 9:30am - 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E Breene can be reached on (703) 305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Leslie Wong
Patent Examiner
Art Unit 2177

lw
December 06, 2003

JEAN R. HOMERE
PRIMARY EXAMINER